



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/697,877	10/31/2003	Tomonori Kato	2003_1576	9008

513 7590 07/31/2006

WENDEROTH, LIND & PONACK, L.L.P.
2033 K STREET N. W.
SUITE 800
WASHINGTON, DC 20006-1021

EXAMINER

TILL, TERRENCE R

ART UNIT PAPER NUMBER

1744

DATE MAILED: 07/31/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/697,877

Applicant(s)

KATO ET AL.

Examiner

Terrence R. Till

Art Unit

1744

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 24 May 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-20 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date 10/03, 8/05.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION***Double Patenting***

1. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the “right to exclude” granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

2. Claims 1, 4, 8, 10, 14 and 17 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-4 of U.S. Patent No. 6,684,451 in view of Toya (US 5,525,888). With respect to claims 1 and 4 of the application, claim 1 of patent ‘451 discloses all of the same subject matter with exception of a notice device on the charger to indicate when the charging terminal is connected. The patent to Toya discloses a charging device having 1 a pilot lamp 86 (see column 4; lines 25-30. Element not shown in Figure 2) to indicate when the charging terminal is connected to the terminal connector of the object to be charged. It would have been obvious to a person skilled in the art at the time the invention was made to provide a notice device to claim 1 of the ‘451 patent in view of the teaching of Toya in order to show a user that a connection has occurred between the charger and the object to be

Art Unit: 1744

charged. With respect to claims 8 and 10 of the application, claims 1 and 2 of the '451 patent disclose all the same subject matter with exception of a notice device on the charger to indicate when the charging terminal is connected. The patent to Toya discloses a charging device having 1 a pilot lamp 86 (see column 4; lines 25-30. Element not shown in Figure 2) to indicate when the charging terminal is connected to the terminal connector of the object to be charged. It would have been obvious to a person skilled in the art at the time the invention was made to provide a notice device to claims 1 and 2 of the '451 patent in view of the teaching of Toya in order to show a user that a connection has occurred between the charger and the object to be charged. With respect to claims 14 and 17 of the application, claims 1 and 3 of the '451 patent disclose all the same subject matter with exception of a notice device on the charger to indicate when the charging terminal is connected. The patent to Toya discloses a charging device having 1 a pilot lamp 86 (see column 4; lines 25-30. Element not shown in Figure 2) to indicate when the charging terminal is connected to the terminal connector of the object to be charged. It would have been obvious to a person skilled in the art at the time the invention was made to provide a notice device to claims 1 and 3 of the '451 patent in view of the teaching of Toya in order to show a user that a connection has occurred between the charger and the object to be charged.

3. It is understood that this application is a Divisional of 10/035,129 which is the patented application applied against the claims for double patenting. It should be noted that when application 10/035,129 was being prosecuted, the Election of Species presented to applicants included figures 43-53 under a single species. These figures were all the figures related to the charger. Therefore, applicant could have presented the claimed subject matter in this application

Art Unit: 1744

in the preceding application without it having been divided up. Further, Although applicants have stated that this application is a Divisional of 10/035,129, for the above reasons it is more likely a Continuation of 10/035,129 as the subject matter claimed is still that of the charger.

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

6. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

Art Unit: 1744

7. Claims 1-20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Sako et al. (US 4,670,701) in view of Toya (US 5,525,888- cited in IDS).

8. The patent to Sako et al. discloses a vacuum cleaner arrangement comprising: a cleaner main body 1 accommodating a secondary battery 11 and a blower 21,24, and having a terminal connector 8 in said cleaner main body and an engaging portion 2 at a lower side of said cleaner main body; a charger 4 having a charging terminal 7 to be connected to said terminal connector for charging said cleaner main body when said cleaner main body is mounted on said charger, and also having a box portion accommodating a power transformer 12; a mounting portion 5a-c for mounting part of said cleaner main body, said mounting portion extending forwardly from a front lower side of said box portion (see figure 2); a mating portion 6 to be engaged with said engaging portion, said mating portion being on said mounting portion; wherein said charging terminal is positioned adjacent a side wall of said box portion. Sako et al. also discloses a guide 5b,c for setting said cleaner main body onto said charger and a handle unit (see figure 1) for manipulating said cleaner main body, wherein a diameter of said handle unit appears less than a width of said box portion. Sako et al. does not disclose a notice device, on said charger, to indicate when said charging terminal is connected to said terminal connector such that power can be supplied from said charging terminal to said terminal connector. The patent to Toya discloses a charging device having 1 a pilot lamp 86 (see column 4; lines 25-30. Element not shown in Figure 2) to indicate when the charging terminal is connected to the terminal connector of the object to be charged. It would have been obvious to a person skilled in the art at the time the invention was made to provide a notice device to the charger of Sako et al. in view of the teaching of Toya in order to show a user that a connection has occurred between the charger and

Art Unit: 1744

the object to be charged. With respect to claims 5, 7, 11, 13, 18 and 20, although, the location pilot lamp 86 of Toya is not shown, it would have been obvious to one having ordinary skill in the art at the time the invention was made to mount it on a top of the box portion, since it has been held that rearranging parts of an invention involves only routine skill in the art. In re Japikse, 86 USPQ 70. Further the top of the box portion 1 of Toya has an "H"-shaped flat surface that would allow this to occur. Such a flat top surface could easily be incorporated into Sako et al. for the purpose of mounting a pilot lamp.

Conclusion


9. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Applicant's other prior patent (6,345,411) and US patents to McGee, Richmond et al. and Lopez show the current state of the art in rechargeable vacuum cleaners.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Terrence R. Till whose telephone number is (571) 272-1280. The examiner can normally be reached on Mon. through Thurs. and every other Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Gladys P. Corcoran can be reached on (571) 272-1214. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Art Unit: 1744

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.


Terrence R. Till
Primary Examiner
Art Unit 1744

trt